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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,122	07/10/2001	Kenneth J. Overton	4904.7-1	9537
23559	7590	08/27/2004	EXAMINER	
MUNSCH, HARDT, KOPF & HARR, P.C. INTELLECTUAL PROPERTY DOCKET CLERK 1445 ROSS AVENUE, SUITE 4000 DALLAS, TX 75202-2790			LAVIN, CHRISTOPHER L	
		ART UNIT	PAPER NUMBER	
		2621		

DATE MAILED: 08/27/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/903,122	OVERTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher L Lavin	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5, 7, 11-15, 17-23, 25, 26 and 28-30 is/are rejected.
- 7) Claim(s) 6, -10, 16, 24, 27 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ .	6) <input type="checkbox"/> Other: ____ .

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because it should be a single paragraph. Correction is required. See MPEP § 608.01(b).
2. The disclosure is objected to because of the following informalities:
3. On page 19, line 5 "800a" should be replaced with "700a".
4. On page 26, line 8 "Figures 18A and 18B" should read "Figures 15A and 15B".
5. On page 26, line 11 "Figure 18" should read "Figure 15".
6. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 6,10, 24, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claims 6,10, 24, and 27 recite the limitation "the increment" in the first line. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 26 is indefinite for depending from an indefinite antecedent claim.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1 – 3, 7, 11 – 15 and 17 – 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Sharir (6,297,853).

13. In regards to claim 1, Sharir in the paragraph starting at column 8, line 51 discloses a method for tracking the duration an advertisement is seen in a video stream. Sharir in the paragraph starting at column 12, line 34-36 discloses summing the time a target area is seen. Inherent in a summation of time is a counter, as the system Sharir disclosed is real-time (paragraph starting at column 7 line 7) it must increment the counter automatically. Sharir also discloses in the paragraph starting at column 11 line 33 that a field is analyzed for inclusion in one or more target areas.

14. In regards to claim 2, Sharir in the sentence starting at column 12, line 32 discloses calculating an occlusion parameter of the target area.

15. In regards to claim 3, Sharir in the sentence starting at column 12, line 27 discloses that a fee may be calculated based on the duration an ad has been seen.

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16. In regards to claim 7, Sharir, as shown in the response to claim 2, discloses that an occlusion parameter is calculated. An occlusion parameter describes how much of the foreground, in this case an ad, is seen. Thus the occlusion parameter is a foreground parameter and meets the requirements of claim 7.

17. In regards to claim 11, Sharir at column 12, lines 27 - 32 discloses that an occlusion threshold of "at least 50%." If the occlusion parameter exceeds this threshold, then no fee is charged. This is equivalent to disallowing the increment as called for in claim 11.

18. In regards to claim 12, Sharir in the paragraph starting at column 7 line 48 discloses that the target area can be a physical billboard or an area where ads are not physically placed, which amounts to "signage existing in a site" as required by claim 12.

19. In regards to claim 13, Sharir in the paragraph starting at column 17 line 42 discloses that the ads shown in a particular target area may vary overtime as may a particular ad's location.

20. In regards to claim 14, Sharir in the paragraph starting at column 7 line 7 discloses that the system is meant to work in real time.

21. In regards to claim 15, Sharir in the paragraph starting at column 8 line 51 discloses collecting statistics on the advertisements shown. In the paragraph starting at column 17 line 42, Sharir discloses a schedule for displaying the ads.

22. In regards to claim 17, Sharir, as previously shown in response to claims 10 and 13, discloses a method of tracking the duration an ad has been shown, which allows for the ad to be moved to different target areas. Inherent in such a design is the ability to

track the total duration of an ad, regardless of how many different locations it is shown in.

23. In regards to claim 18, Sharir in the paragraph starting at column 4 line 46 discloses a databank of ad locations for a particular venue. Such a databank acts as a model of the target areas of the site. The rest of the claim is dealt with in claim 1.

24. In regards to claim 19, Sharir in the sentence starting at column 10 line 5 discloses that the image capture and image insertion modules are contained within software. As shown previously in claim 1 the system keeps track of the duration of each ad, therefore a duration module must be included within the software system Sharir discloses.

25. In regards to claim 20, Sharir, as shown in claim 19, discloses a system of modules to handle the entire process of image insertion into a stream. Since Sharir discloses a duration module, that module must be contained somewhere within the image insertion system.

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

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were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

28. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

29. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharir in view of Agnihotri (6,731,788).

30. In regards to claim 4, Sharir in the sentence starting at column 12 line 32 discloses an occlusion parameter using the occluded area and the target area. This teaching has everything in common with claim 4 except for explicitly stating that the areas would be calculated based on the pixel count of the two regions.

31. Agnihotri teaches in his prior art (column 10 lines 30 – 32) that pixel count can be used to represent the area of a particular structure.

32. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to use pixel count (as taught by Agnihotri) to compute the occlusion parameter. As pixel count is readily available in the system described by Sharir using

pixel count would be an easy and efficient way to compute the area of regions that are often nonstandard shapes.

33. In regards to claim 5, Sharir in the sentence starting at column 12 line 32 discloses that a ratio of the occluded area and the target area are used to find the occlusion parameter.

34. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharir in view of Gloudemans (6,266,100).

35. In regards to claim 21, Sharir in the figure 10B discloses the image separator and the occlusion separator modules set forth in claim 21. The Image separator consists of steps 290 through 340 in figure. A target area is identified, segmented and in step 330 an advertisement is incorporated into the target area. The occlusion separator module consists of steps 350 – 360. In step 350 the occlusion parameter is determined. Finally at column 4 lines 46 – 50 Sharir discloses a model renderer. However, Sharir does not disclose a three dimensional model of the venue.

36. Gloudemans teaches in his prior art (column 2 line 50) that a three-dimensional model of a stadium should be used for ad placement.

37. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the ad insertion system of Sharir to use a three-dimensional model of the venue. As such a model would allow for more accurate placement of ads.

38. In regards to claim 22, Sharir in the sentence starting at column 12 line 32 discloses calculating an occlusion parameter of the target area.

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39. Claims 23, 25, 28 - 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sharir in view of Gloudemans as applied to claims 21 and 22 above, and further in view of Agnihotri.

40. In regards to claim 23, please see the rejection of claim 5.

41. In regards to claim 25, Sharir, as shown in the response to claim 22, discloses that an occlusion parameter is calculated. The occlusion parameter is a foreground parameter, as explained earlier.

42. In regards to claim 28, please see the rejection of claim 11.

43. In regards to claim 29, please see the rejection of claim 12.

44. In regards to claim 30, please see the rejection of claim 17.

***Allowable Subject Matter***

45. Claims 8, 9, and 16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

46. Claims 6, 10, 24, 26, and 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

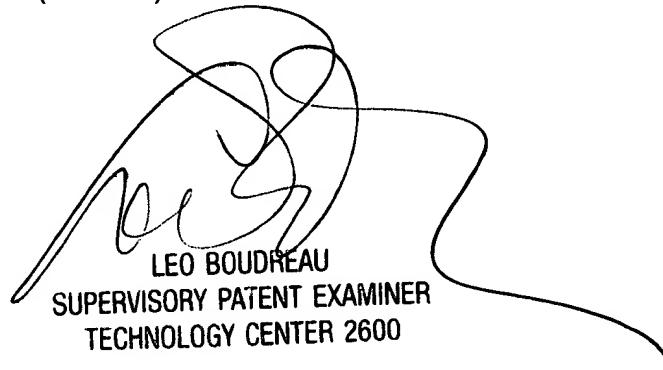
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L Lavin whose telephone number is 703-306-4220. The examiner can normally be reached on M - F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau can be reached on (703) 305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CLL



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